

REMARKS

I. Introduction

In response to the Office Action dated August 20, 2004, claims 1, 6-7, 13-19, 22, 23, 28-29, 35-41, 44, 45, 50-51, 57-63 and 66 have been amended. Claims 1-66 remain in the application. Re-examination and re-consideration of the application, as amended, is requested.

II. Information Disclosure Statement

Applicant's attorney notes that the PTO-1449 for the Information Disclosure Statement (IDS) submitted on February 27, 2002 was not returned with the Office Action, although the IDS is listed on PAIR as being received by the Office on March 11, 2002. In a telephone conversation on September 30, 2004, the Examiner indicated that the file wrapper did not contain a copy of the IDS, and that Applicant's attorney should re-submit the IDS.

A copy of the IDS, including the transmittal documents, IDS, form PTO-1449 and returned postcard, is being submitted herewith. Applicant's attorney notes that no interlineations were made by the Office on the returned postcard, indicating that the Office received the IDS, although it was apparently lost by the Office after receipt. Consequently, Applicants' attorney asserts that no fee, certification or petition is required for entry of this IDS, because of its prior proper submission. Consequently, Applicants' attorney requests that the form PTO-1449 be returned with the entries initialed by the Examiner.

III. Non-Art Rejections

On page (2) of the Office Action, claims 22, 44, and 66 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant's attorney has amended claims 22, 44, and 66 to overcome this rejection.

IV. Office Action Subject Matter Rejection

On page (3), the Office Action rejects claims 1-7, 13-22, 45-51, and 57-66 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Applicant's attorney has amended the claims to overcome this rejection. However, should issues still remain in this regard, Applicant's attorney requests that the Examiner indicate how the rejection can be overcome, in accordance with the directives of the Examination Guidelines for

Computer-Related Inventions. See Guidelines II M.P.E.P. § 2106. Specifically, should it be necessary, the Applicant requests that the Examiner identify features of the invention that would render the claimed subject matter statutory if recited in the claim. See Guidelines IV, M.P.E.P. § 2106.

V. Prior Art Rejections

On page (4) of the Office Action, claims 1-16, 19-38, 41-60, and 63-66 were rejected under 35 U.S.C. §103(a) as being unpatentable over Padwick, "Special Edition Using Microsoft Outlook 2002," (Padwick) in view of Rand et al., U.S. Publication No. US 2004/0080528 A1 (Rand). On page (17) of the Office Action, claims 17 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Padwick in view of Rand, and further in view of Abu-Hakima et al., U.S. Publication No. 2003/0020749 A1 (Abu-Hakima).

Applicant's attorney respectfully traverses these rejections, in view of the amended claims above and the arguments below.

The Office Action asserts that the combination of Padwick, Rand and/or Abu-Hakima renders obvious all the elements of the Applicant's claims. Applicant's attorney disagrees.

Specifically, none of the references teach or suggest making alterations to an electronic message to identify message terms in the electronic message that match significant terms stored in the online registry. Instead, the references merely search emails or other text for a particular term or phrase, and then highlight the display of that particular term or phrase when found, but without altering the message, email or text itself.

Moreover, none of the references teach or suggest an online registry that stores significant terms. Instead, the references merely describe search tools that include dialogs and rules wizards that execute rules. However, nowhere do the references describe significant terms stored in a registry that are used to make alterations to the messages.

Thus, even when combined, the references teach away from Applicant's invention. Moreover, the various elements of Applicant's claimed invention together provide operational advantages over the references. In addition, Applicant's invention solves problems not recognized by the references.

Thus, Applicant submits that independent claims 1, 23, and 45 are allowable over the references. Further, dependent claims 2-22, 24-44, and 46-66 are submitted to be allowable over the references in the same manner, because they are dependent on independent claims 1, 23, and 45,

respectively, and thus contain all the limitations of the independent claims. In addition, dependent claims 2-22, 24-44, and 46-66 recite additional novel elements not shown by the references.

VI. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

Respectfully submitted,

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